

REMARKS

Claims 1-21 are pending. Claims 8-14 are withdrawn.

I. The Restriction Requirement and Applicant's Provisional Election

The Examiner required restriction, under 35 U.S.C. §§ 121, 372, and considers the application to contain separate and distinct inventions, directed to 2 groups designated Groups I-II as these inventions or groups of inventions allegedly are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Additionally, the Examiner believes that Groups I and II contains multiple species. Therefore, the Examiner believes a particular species of cancer must be selected. See Office Action, pp. 2-3.

In response, Applicants hereby elect, **with traverse**, Group II, claims 15-21, drawn to a therapeutic method. Applicants also elect, **with traverse**, breast cancer, for examination.

Applicants note that upon allowance of any linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise requiring all of the limitations of the allowable linking claims will be rejoined and fully examined for patentability in accordance with 37 C.F.R. 1.104.

II. The Inventions of the Current Application Exhibit Corresponding Special Technical Features

Applicants traverse the restriction requirement because the unity of invention standard must be applied in national stage applications. Section 1850 of the Manual of Patent Examining Procedure (revised 8th edition, published August, 2006) (hereinafter "MPEP") provides that

when the Office considers international applications . . . during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111

. . .

In applying PCT Rule 13.2 to . . . national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2

MPEP at page 1800-94.

MPEP section 1893.03(d) reiterates the Examiner's obligation to apply the Unity of Invention standard PCT Rule 13.2 instead of U.S. restriction/election of species practice:

Examiners are reminded that unity of invention (not restriction) practice is applicable . . . in national stage applications submitted under 35 U.S.C. 371.

Id. at page 1800-199, col. 2.

The present invention is directed to a method for the treatment of solid cancers. Examples 1 and 2 show that an anti-HM1.24 antibody has ADCC activity common to different solid cancers. This is a "special technical feature" shared by all of the inventions in this application. All of the claims should, therefore, be examined together in one application.

Thus, in the present case, unity of invention does exist between all claims. Therefore, Applicant respectfully requests that the Examiner withdraw the Restriction Requirement, and examine the invention.

III. The Search Of Groups I-II and Additional Cancer Species Is Not Unduly Burdensome

Applicants also traverse the restriction requirement on the grounds that the search and examination of Groups I-II and additional cancer species is not unduly burdensome. According to MPEP section 803 "if a search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent and distinct inventions." Applicants suggest that examination of Groups I-II, directed to methods of treating solid tumors using specifically provided and claimed agents, can be made without serious burden and it is respectfully requested that all claims be rejoined with the claims of Group II. In addition, Examples 1 and 2 show that the methods are relevant to solid tumors, in general, not only to specific types of cancer. As

treatment of these cancers are provided in the same classification, and no evidence has been provided that they have a separate classification in the art or are provided in divergent fields for searching purposes, the examination of cancers beyond breast cancer is not unduly burdensome. See MPEP 808.02.

IV. Conclusion

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.


If there are any fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 19-0741. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should be charged to our Deposit Account.

Respectfully submitted,

Date June 12, 2007

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5571
Facsimile: (202) 672-5399

By 

 Harold C. Wegner *Reg No 35,264*
Attorney for Applicant
Registration No. 25,258